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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,118	06/07/2001	Kulvir Singh Bhogal	AUS9200010352US1	1243

7590 06/02/2005
Cynthia S. Byrd
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EXAMINER

COLLINS, SCOTT M

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/876,118	Applicant(s) BHO GAL ET AL.	
	Examiner Scott M. Collins	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-12 examined.
2. It is hereby acknowledged that the following papers have been received and placed of record in the file: Amendment on 01/06/2005.

Response to Arguments

3. Applicant's arguments filed 01/06/2005 have been fully considered but they are not persuasive. In regards to claims 1-2, 5-6, and 9-10, Applicant argues that the Beck reference does not teach "downloading Web content associated with the hyperlink into the message store at the server"; however, in column 13, lines 31-39, Beck explicitly teaches that the recipient can easily download the Web content associated with a hyperlink. Applicant's allegation that the reference teaches away from the claimed invention is in contradiction to the invention as claimed since the content can be downloaded at any time.
4. In regards to claims 3, 7, and 11, Applicant argues that Beck does not teach the limitations of "determining whether the Web content exceeds a predetermined size and in response to determining that the Web content exceeds a predetermined size, compressing the Web content that exceeds a predetermined size, at the server". However the newly added limitations only make explicit that which was inherent in the original version of these claims. In order to compress the Web content that exceeds a predetermined size, the system must determine if the Web content exceeds the predetermined size. The examiner stands on the previous rejection. In regards to claims 4, 8, and 12, the Examiner stands on the rejection that column 13, lines 31-39 of the Beck reference does indeed teach the ability of the client to download the Web content at any set time.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Beck et al., U.S. Patent Number 5,903,723 (herein referred to as Beck).

7. Referring to claims 1, 5, and 9, Beck has taught a distributed computer system including a server and a client, the server including a message store, a method (or a computer program product having computer code on a computer readable medium) for delivering Web content within a body section of electronic mail messages (Beck figure 6) comprising:

a. receiving at a server, at least one mail message containing an embedded hyperlink (Beck column 5, lines 6-33);

b. downloading Web content associated with the hyperlink into the message store at the server (Beck column 5, lines 6-33 and column 13, lines 31-39); and

c. transmitting the mail message and the corresponding Web content for display at the client (Beck column 5, lines 6-33).

8. Referring to claims 2, 6, and 10, Beck has taught the method (or product) further comprising:

a. detecting, at the server, plurality of incoming mail messages containing a common hyperlink (Beck column 5, line 34 – column 6, line 12; column 8, line 56 – column 9, line 16);

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- b. tagging each incoming mail message containing the common hyperlink (Beck column 5, line 34 – column 6, line 12; column 8, line 56 – column 9, line 16);
- c. storing one copy of the Web content associated with the common hyperlink in the message store at the server (Beck column 5, line 34 – column 6, line 12; column 8, line 56 – column 9, line 16); and
- d. parsing the hyperlink when a tagged message is sent to the client (Beck column 5, line 34 – column 6, line 12; column 8, line 56 – column 9, line 16).

9. Referring to claims 3, 7, and 11, Beck has taught the method (or product) further comprising determining whether the Web content exceeds a predetermined size and in response to determining that the Web content exceeds a predetermined size, compressing the Web content that exceeds a predetermined size, at the server (Beck column 6, lines 38-60).

10. Referring to claims 4, 8, and 12, Beck has taught the method (or product) further comprising:

- a. determining whether the client has a preset time for downloading messages containing Web content (Beck column 13, lines 31-39); and
- b. in response to determining that a preset time for downloading Web content exists, caching the message and Web content at the server until the preset time is reached (Beck column 13, lines 31-39).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Collins whose telephone number is 571.272.3934. The examiner can normally be reached on Mon.-Fri. 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571.272.6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smc
May 27, 2005


VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER